Pertinent Decisions and Orders Relating to Some of the Rules of the Rules of Practice

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BY

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Pertinent Decisions and Orders Relating to Some of the Rules of the Rules of Practice.

This paper is intended to cover a few pertinent decisions and Commissioners' orders relating to certain of the Rules of Practice. I have by no means made an exhaustive search of all the decisions bearing on the rules to which I refer. My object is mainly to bring to your attention decisions that were rendered before Underwood's Digest was published, decisions and orders that bear on questions arising in the examination of applications for Letters Patent. Some of the rules were given their present form in view of these decisions. All the decisions and orders cited set forth what I consider good practice.

Rule 5. "An assignee of the entire interest of an invention is entitled to hold correspondence with the office to the exclusion of the inventor."

There is but one decision that bears on this rule to which I wish to call attention, namely, Ex parte Baker, Commissioner's MSS., vol. 41, 1889, page 289. In the Baker case the Examiner had required the power of attorney given by the inventor to be ratified by the assignee of the entire interest of the invention before the office would further recognize the attorney in the prosecution of the application. In considering this question on petition, Commissioner Mitchell said:

> "Unquestionably the assignee, under Rule 5, is entitled to hold correspondence with the office to the exclusion of the inventor, whenever he asserts that right; but the office ordinarily acts upon the presumption that the assignee of the whole interest will assert his right, unless he is willing to be represented by the attorney of the inventor. Until the assignee does assert this right it is the practice of the office, to be deviated from

> only in exceptional cases, to recognize a correspondingly exclusive right on the part of the attorney for the inventor."

Rule 6. "When there has been an assignment of an undivided part of an invention, amendments and other actions requiring the signature of the inventor must also receive the written assent of the assignees."

In considering this rule I find that there are five instances in which amendments and other actions require the signature of the inventor and therefore the written assent of the assignee of an undivided part of an invention. They are concessions of priority, abandonment of an application, disclaimer to avoid an interference, application for reissue, and power of attorney.

Another feature worthy of consideration in connection with Rule 6 relates to an assignee of an undivided part of an invention within and throughout a specified part of the United States. This assignee is not such as would come under Rule 6, as was fully discussed in Ex parte Funston, C. D., 1889, page 223.

Funston was the assignee of an undivided part of the invention throughout a specified part of the United States in two applications of David Savage. Funston asked that he be allowed to join with Savage in the prosecution of the applications. It may be of interest to hear what Commissioner Mitchell said on this point:

> "Considerable discussion has been indulged in as to what constitutes an assignee and the meaning of the word in the different rules, and Funston insists that he is such an assignee as could maintain suit for infringement of his patent right if a patent had been granted to Savage, and that consequently he should be allowed to prosecute jointly with Savage. Reflection upon this point in the case must make it clear that it would not be policy to allow any one but an assignee who is the owner of an undivided part of the entire invention to prosecute an application, owing to the great confusion that would necessarily result; for if it should be held that any assignee of the right to an undivided part of the invention within

> and throughout some specified part of the United States could prosecute an application, where could the line ever be drawn with certainty. An inventor might assign an undivided half of his invention to a different person in each of the different States, each one of whom would be such an assignee as would, upon the construction put upon Rule 6 by Funston's attorneys, be entitled to prosecute an application. Such a state of affairs was not contemplated or intended to be brought about by the framers of Rule 6."

Rule 8. "A double correspondence with the inventor and an assignee, or with a principal and his attorney, or with two attorneys, can not generally be allowed."

I need take but a minute of your time to refer to but one decision in reference to this rule, namely, Ex parte Jewett, C. D., 1887, page 17. In this case two principal attorneys were appointed by the applicant, one resided in San Francisco, Cal., and the other in this city. The applicant failed to designate which one the office should hold correspondence with. In discussing this point, Commissioner Hall set forth the practice as follows:

> "Simply as a matter of practice, it would be well, undoubtedly, where, like the present case, one independent firm located in some other city and another independent firm located in this city are each and both nominated as principal attorneys, for the office, in the absence of any direction or indication of the intention or wishes of applicant or of the attorneys themselves, to conduct its correspondence with the resident firm."

Rule 14 relates primarily to information and advice to be given by the office in response to inquiries about subject-matter not pending before the office. However, the part that concerns us is found in the last three lines of paragraph 1, and is as follows:

> "nor can it act as an expounder of the patent law, nor as counsellor for individuals, except as to questions arising within the office."

This part of the rule has been construed as giving the Examiner ample authority to advise an applicant concerning questions of novelty which he has disclosed in his application but has failed to claim. I wish to quote briefly from two decisions to bring out what two Commissioners, for whose opinions I have the highest regard, considered good procedure under this part of Rule 14. The first one is Ex parte Donovan, C. D., 1888, page 100.

This case came before the Commissioner on petition from the action of the Examiner refusing to enter an amendment presenting a new claim which applicant contended that the Board of Examiners-in-Chief had recommended in their decision on an appeal. Commissioner Hall, in considering the refusal of the Examiner to enter the amendment, said:

> "The rules of the office . . . point out that at all times in the investigation of an application and in the progress of appeals it is the duty of each tribunal having jurisdiction of the case to see to it that the inventor shall secure a patent for whatever patentable matter may be shown in his application. As has been frequently stated by me in decisions, the office must put itself in the attitude of a friend and not of a litigant with the applicant, and see that he secures every right that belongs to him.
>
> "Now, unquestionably, if under Rules 68 and 139 it is the duty of the Examiners-in-Chief and the Commissioner to suggest and recommend in order that an applicant may receive letters patent for subject-matter not involved in the appeal, it must be the duty of the Primary Examiner in the examination of the case made by him to point out and recommend the same thing. I do not mean by this that it is the duty of the Examiner to become an agent or an attorney for the applicant, but I think in all cases when he is satisfied or believes that the application contains patentable matter which is not claimed, it is his duty to advise the applicant briefly and specifically, precisely as the Examiners-in-Chief and the Commissioner are authorized to do, as above stated."

The other decision is Ex parte Bailey, C. D., 1890, page 123, by Commissioner Mitchell, wherein the same point arose as in Ex parte Donovan. The Commissioner said:

> "As to the second point, the Examiner states that Rule 14 is distinct and reflects the settled practice in stating that the office can not act as counsellor for individuals. Rule 14 makes an exception 'as to questions arising within the office.' The cases are not relatively numerous in which unsought advice should be tendered, but where advice is asked there is no reason why it should not ordinarily be given. The correct practice is laid down by Commissioner Hall in Ex parte Donovan, C. D., 1888, 100, and I desire to emphatically express my concurrence in the views set forth in that case."

Rule 19. "Substitution or association can be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second agent to appoint a third."

I wish briefly to refer to but one decision in connection with this rule, namely, Ex parte Ranks, C. D., 1887, page 7. In the Ranks case an associate attorney was appointed by the applicant without the consent of the principal attorney. In considering the appointment the Commissioner held that an associate attorney can not be nominated by an applicant without the consent of the principal attorney. If this were permitted it would probably result in confusion in the prosecution of the application. The regular course would be for the principal attorney to nominate his associate upon the written authorization of his client. The nomination of an associate attorney made by an applicant without the consent of the principal attorney can not be recognized or acted upon.

Rule 34. "The specification is a written description of the invention or discovery and the manner and process of making, constructing, compounding, and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art

or science to which the invention or discovery appertains, or with which it is most nearly connected, to make, construct, compound, and use the same."

The first decision to which I wish to call your attention is Ex parte Kerr, C. D., 1884, page 27. The case was before the Commissioner on petition to have the Examiner's objection that the specification was not full and sufficient withdrawn. The decision is interesting merely by reason of the Commissioner's interpretation of the meaning of the words "skilled in the art," which were as follows:

> "The solution of this question turns upon the interpretation which should be given the words 'persons skilled in the art.' By these words I do not think is meant persons who excel their fellows in particular arts or sciences in which they are skilled, but merely men who have ordinary or fair information in that particular line."

The next point I wish to refer to in considering Rule 34 is, in my opinion, an important one; that is, the description of constructions in specifications that are not shown on the drawing. In my experience as an assistant Examiner I found that in at least 50 per cent of the applications I examined, the specifications thereof described modifications not illustrated on the drawings. Since examinations are made mostly by "an inspection of the drawings," applicants should be required to illustrate on the drawings all modifications described in the specification or cancel the description thereof. This practice is fully warranted and clearly set forth in Ex parte Witty and Caffrey, C. D., 1884, page 26, in which Commissioner Butterworth said:

> "Whether a particular modification described in the application is simply a mechanical equivalent it may sometimes be difficult to determine. Counsel is aware that examinations are conducted, in the main, by an inspection of the drawings. It is, therefore, not only proper, but necessary, that each drawing shall disclose as fully as possible the invention, and also the substantial

> modifications thereof, in order that two patents may not be issued for the same thing, thus doing injustice to the public and to the patentees."

Another point in connection with Rule 34 may be briefly referred to by reference to two decisions wherein a reference in the specification to a co-pending application for a full disclosure of the construction was held not to be sufficient.

The first of these decisions is Ex parte Borgfeldt, C. D., 1889, page 199. The drawings in the Borgfeldt application disclosed a machine and the claims covered a process. The description was not sufficient to give a clear understanding of the machine. Applicant undertook to overcome an objection to this effect by a reference in the specification to a co-pending application which fully described the machine. Commissioner Mitchell, in commenting on this point, said:

> "The Examiner is correct in holding that a reference to a contemporaneously-pending application for a fuller description is not permissible. It can not be assumed that the application referred to will mature into a patent."

The second decision is Ex parte Chadwick, C. D., 1891, page 169. The Chadwick application was for an improvement on a machine disclosed in a pending application filed by another inventor. Reference was made in the Chadwick application to the co-pending application for a full disclosure of certain parts of the machine. On this point Commissioner Mitchell said:

> "Descriptions contained in pending applications are not portions of the prior art. Such applications may become abandoned by failure to prosecute, they may become forfeited by reason of nonpayment of final fee, or for other reasons they may never mature into a patent. The office can not act upon the assumption that applications will necessarily mature into patents, and Rule 36 is not satisfied by a reference to pending

> applications for the parts which 'necessarily co-operate with' the specific improvement for which a patent is asked."

Another point of interest which may be briefly referred to in connection with Rule 34 is the practice laid down in Ex parte Lewis and Unger, C. D., 1903, page 303. Lewis and Unger filed two applications, as joint inventors, and prosecuted claims in both to final rejection. On appeal to the Board of Examiners-in-Chief the Examiner was reversed as to certain claims in both applications and the board recommended that all the patentable claims should be embodied in one of the applications, which recommendation was complied with and the Examiner passed the application to issue. The applicants then filed a new application containing the allowed claims, but did not make a reference therein to the prior applications. The next day applicants abandoned the prior applications. The Examiner required applicants to insert a reference in the specification of the new application identifying the prior applications. On petition from this requirement Commissioner Allen said:

> "It is clear from the letter of abandonment . . . that the applicants intend to retain all benefits which may result to them from their prior applications; but they apparently wish to conceal that matter from the public until it becomes necessary to use it. In other words, the result is that after the patent is issued they may use the applications for their own benefit if the occasion required; but the public is deprived of the right of using whatever there may be in the record of those applications to the prejudice of the rights of the patentees. The public will furthermore be deceived and misled as to the record date to which the patentees are entitled."
>
> "When the patent is granted, all proceedings leading to its grant should be public property. The rule of secrecy no longer applies to those proceedings."

The Commissioner in the following paragraph set forth and instituted the practice as follows:

> "It is held that the present application should not be allowed without a reference to the prior applications and that there should be indorsed upon the file wrapper a statement that it is a continuation of those applications. This indorsement should take the place of that usually indorsed upon divisional applications."

In Ex parte Taylor, Jr., C. D., 1905, page 45, the circumstances were a little different from those in Ex parte Lewis and Unger. The Taylor application was allowed and forfeited and a new application was filed for the same construction, presenting the sole claim of the forfeited application. The Commissioner held that the new application was a continuation of the first application and that the new application should contain a notice of the first application, for the reasons set forth in Ex parte Lewis and Unger.

Another decision bearing on this point is Ex parte Kruse, C. D., 1910, page 119. In the Kruse application a part of the disclosure was for the same subject-matter as the disclosure in a previous application to the same inventor. The Commissioner in this case held that a subsequent application is a continuation of a prior application, when the two have common subject-matter as in this case.

Commissioner Moore found that attorneys were somewhat careless in amending cases in accordance with the practice laid down in the last three above referred to decisions. Frequently applications were found to be otherwise in condition for issue and the requirement of the insertion of a reference in the specification identifying the parent application or the application of which the present application is a continuation had not been complied with. Consequently another action on the part of the office insisting on the requirement of the insertion of the reference in the specification was necessary. So in order to facilitate the work of the office, the Commissioner, on October 10, 1912, issued Order No. 2010,

which sets forth the practice to be followed in cases of this character, and is as follows:

> "When an application is filed which in the opinion of the Examiner is a division of, a continuation of, or a substitute for a previously filed application but which contains no reference to such prior application, the Examiner will require applicant to insert the proper reference to the prior application in the specification. If, when the case is otherwise in condition for allowance, this requirement has not been complied with nor shown to have been improperly made, the proper reference to the prior application will be made by an Examiner's amendment, and the application passed to issue forthwith."

This order was modified by Commissioner Ewing September 19, 1913, by Order No. 2071, which is as follows:

> "When an application is filed which in the opinion of the Examiner is a continuation of or a substitute for a previously filed application, the Examiner will not require applicant to insert a reference to the prior application in the specification, it being regarded as sufficient if this reference appears somewhere in the record of the application. The Examiner will make the appropriate entry upon the face of the file wrapper. The heading of the printed patent will conform to this entry."

There are many contingencies sure to arise under this order that have not been settled by any decision as yet published. For example, suppose an applicant files a parent application containing two inventions, he then divides and files a second application containing one of the inventions plus new matter, should any entry thereof be made on the file wrapper of the parent application? The second application being only a continuation in part of the parent application.

Just one more reference involving Rule 34, which relates to the filing of substitute specifications. The

practice relative thereto is found in Ex parte Orewiler, C. D., 1911, page 100. This case came before the Commissioner on petition from the action of the Examiner in refusing to enter and consider a substitute specification. In declining to grant the petition, Acting Commissioner Billings said:

> "There is a grave objection to the filing of substitute specifications in that such action requires the office not only to examine the substitute specification to determine whether it is in proper form and meets the requirements of the law, but also to carefully compare the same with the original disclosure in order to determine whether new matter has been inserted therein."

One can hardly fail to realize what a saving of labor this practice establishes, especially when you take into consideration heavy machine cases.

Rule 37. "The specification must conclude with a specific and distinct claim or claims of the part, improvement, or combination which the applicant regards as his invention or discovery."

A paper of considerable length could be written relative to this rule by reason of the many decisions of the Commissioners. However, I shall refer only to one question which I have found frequently arises in the examination of applications, and that is the use of alternative phrases or terms in claims.

One or two of the Commissioners' decisions seem to warrant the use of alternative terms when the terms are equivalents. However, the majority of the decisions discourage their use. It seems to me to be good practice not to allow alternative terms in claims at all, for if the terms are equivalents only one is necessary and if they are not equivalents they render the claim indefinite. If this practice is followed there would be no possibility of the question of indefiniteness arising in any litigation in which the patent may become involved. In connection with this subject I wish to call attention to four decisions, which seem to me to warrant the practice herein stated.

In Ex parte Holden, C. D., 1903, page 442, the words

"rods or wires" were used in claim 2 to designate certain parts of the apparatus. Commissioner Allen said:

> "The applicant does not disclose two structures to one of which he applies the term 'wires' and to the other the term 'rods,' but applies both terms to the same structure. The apparent alternativeness is one of language merely and not of structure. If both of these terms describe the structure correctly, there is no reason for objecting to the phraseology 'wires or rods.' "

While the alternative phrase used was held to be permissible, the decision warrants the practice above indicated. For if the "alternativeness" is one of "language merely" then either one of the words used is sufficient to give applicant full protection and all possibility of criticism is avoided.

In Ex parte Cook, C. D., 1890, page 81, the applicant used in the claims the expressions "brush or equivalent cleaning device" and "brushes or equivalent cleaning devices." In discussing this point Commissioner Mitchell said:

> "In his first four claims applicant does not employ comprehensive designating language applicable alike to all the forms of the device. If the applicant can devise some one form of expression which comprehends the patentable novelty which is common to all of the forms and styles shown and described, he is clearly entitled to employ that expression to cover the generic invention, and also to claim specifically whichever of the specific forms he may elect to cover and protect. An inventor is always entitled to equivalents—that is to say, to devices which operate in substantially the same way to accomplish substantially the same result in a combination. In the present case if the applicant desires nothing more than the benefit of the law of equivalents, the expression 'or equivalent cleaning device' is surplusage. If he desires some advantage beyond that which the law of equivalents gives him, he is seeking more than can properly be accorded to him."

In Ex parte Caldwell and Barr, C. D., 1906, page 58, petition was taken to the Commissioner from the Examiner's objection that the terms "a mixing compartment containing a quantity of coke or the like," in claim 2, and "a casing containing a mass of coke, brick, or the like," in claim 3, were indefinite. In denying the petition Commissioner Allen said:

> "It is always objectionable to use in the claims words of description which are alternative in form, and this is true even where it appears from consideration of the whole case that the words are not intended to convey alternative or inconsistent ideas. Where possible, some terms of description should be used which are generic."

In Ex parte Phillips, C. D., 1908, page 195, the phrase "asbestos or its equivalent" was used in the claim. Acting Commissioner Billings, in criticising the phrase, said:

> "The objection to the use of the expression 'or its equivalent' is believed to have been properly made. It is objectionable to use terms which are alternative in form, and where possible some terms of description should be used which are generic."

Rule 40. "The specification must be signed by the inventor or by his executor or administrator. . . . Full names must be given."

It is only necessary to dwell on this rule for a minute as the practice is laid down and well defined in Ex parte Gentry, Commissioner's Order No. 600; Ex parte Clark, C. D., 1906, page 339, and Commissioner's Order No. 2018.

In Ex parte Gentry, C. D., 1888, page 115, the Examiner had objected to the applicant's signature to the specification which was signed "N. Kate Gentry" as being incomplete. In affirming the action of the Examiner, Commissioner Hall said:

> "The law knows but one Christian name. The middle names are mere matter of ornament or of social distinction, and it is well settled that an omission of the middle name, or of the initial of the middle name, is wholly immaterial."

In order to make the practice, as laid down in Ex parte Gentry, uniform, Commissioner Mitchell, on June 4, 1890, issued Order No. 600, which is as follows:

> "When the full first name of the applicant does not appear either in his signature or in the preamble to the specification, the Examiner will, in his first official letter, require an amendment supplying the omission, and he will not pass the application to issue until the omission has been supplied, unless an affidavit shall have been filed setting forth that the full first name is the one originally given by him."

In Ex parte Clark it was held that when different forms of applicant's name appeared in the preamble and signature to the specification, one of them a corruption or nickname, an affidavit should be furnished setting forth applicant's correct name. If the incorrect form is in the preamble, correction should be made by amendment.

In order to avoid unnecessary delay in passing applications to issue, Commissioner Moore, on November 11, 1912, issued the following order:

> "Order No. 2018. Supplementing Order No. 600. In applications otherwise ready for allowance, where the first name of the applicant is disclosed in the record but does not appear in the preamble to the specification, the Primary Examiner will insert first Christian name of the applicant by amendment to the preamble, on form No. 2254."

Rule 42 relates to applications presenting claims for separate and independent inventions. It involves the very interesting question of division and affords subject-matter on which a book could be written. As my time limit will not admit of an extended consideration of any one question owing to the scope of the matter I have undertaken to cover, I shall refer to one line of practice only which may properly fall under this rule, and that is the practice which relates to genus and species claims.

The practice relating to genus and species claims was clearly laid down for the first time in Ex parte R. N. Eagle, C. D., 1870, page 137, and has been the settled practice from that date to the present day. It may be of interest to note that the practice relating to genus and species claims is the only practice with which I am familiar that has stood undisturbed for so long a time.

In Ex parte Eagle, the subject-matter of the specification was a tin blacking box, having resting on the top of the blacking, to act as a follower, a foraminous plate, there being several forms of the plate shown and described. The four claims of the application were broad enough to cover all the forms; in other words, they were generic to all the figures of the drawing. The Examiner required the applicant to limit his application to a single species. In considering this requirement, Commissioner Fisher said:

> "The applicant describes a new genus, to wit, a box provided with a follower. He may fairly describe several species of the genus, and may take any claim that is generic in its character and included them all. In addition to this, as the genus can only be illustrated by at least one of the species, he may select one of the embodiments of his invention for specific claims; but he can not found one claim on one species, and a second on another, and a third on another, and so on."

If any one desires to go further into this question attention is called to the decision of Acting Commissioner Doolittle in Ex parte Howland, C. D., 1877, page 120, and that of Commissioner Paine in Ex parte Heaton, C. D., 1879, page 95, both of which affirmed the practice laid down by Commissioner Fisher.

Rule 46 relates to the oath to an application. This rule brings to our attention our old friend Ex parte Branna, C. D., 1901, page 232. The question in this case, you will doubtless recall, was whether the time intervening between the date of executing the oath and the date of filing the application complete was reasonable. The time intervening was thirty-one days, which the Commissioner held to be unnecessarily long and insisted

upon the requirement of a new oath. To have proper "force and value" when questions of public use and sale, publications, and prior patents are concerned the application should be filed immediately after the execution of the oath.

In determining what is a reasonable time, Commissioner Allen, in Ex parte Branna, set forth as a general rule the following:

> "As a general rule it may be stated that the requirement for an additional oath should be made where the delay was longer than three weeks in addition to the time which may naturally be expected to be required in transmitting the papers by mail to this office."

Ex parte Branna does not apply in divisional applications because the divisional application is in effect a part and continuation of the parent application. Ex parte Davison, C. D., 1912, page 94.

Rule 48 requires a supplemental oath when a claim is presented for matter "originally shown or described but not substantially embraced in the statement of invention or claim originally presented."

The main reason I have for considering Rule 48 is the frequent misunderstanding of the function of the rule. I have found in several instances attorneys who professed to believe that new matter could be introduced into an application when supported by a supplemental oath, and I have known assistant examiners who were of the same opinion.

New matter can not be introduced into an application properly under any circumstances. The sole purpose of a supplemental oath is clearly stated in Rule 48, and it can be used only to support . . . "Matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented."

This point was clearly set forth by Commissioner Mitchell in Steward *vs.* Ellis *vs.* Lee *vs.* Howe, C. D., 1889, page 243, as follows:

> "The office of a supplemental oath, as set forth in Rule 48, is to justify the introduction by amend-

> ment of a claim not substantially embraced in the statement of invention or claim originally presented. Rule 48 affords no justification for the introduction of matter by way of amendment which is not substantially described or disclosed in the application, whether with or without a supplemental oath. To so construe Rule 48, as to warrant the introduction of what is commonly known as 'new matter' would be to ascribe to it a function utterly without warrant of law."

Just one more decision in connection with this rule and that relates to the form of a supplemental oath. In Ex parte Cook, C. D., 1892, page 232, the Examiner evidently judging from the character of his action was of the opinion that the forms given in the Rules of Practice were mandatory. Here is what Commissioner Mitchell said in considering that point:

> "It is not necessary that a supplemental oath filed under Rule 48 of the Rules of Practice specify the serial number and date of filing of the application to which it refers if the proposed amendment is otherwise properly identified. The forms given in the Rules of Practice are suggestive and not mandatory."

Rule 50. "The drawing may be signed by the inventor or the inventor's name may be signed thereon by the attorney, and must be attested by two witnesses."

In Ex parte Kyle, C. D., 1890, page 84, the question between the Examiner and the attorneys was whether the two witnesses on the drawing attested the drawing or the signature to the drawing. The attorneys insisted the witnesses attested the drawing, while the Examiner maintained they attested the signature to the drawing and therefore the member of a firm of attorneys who personally signed the drawings was not a competent witness. In commenting on this point Commissioner Mitchell said:

> "I have been at considerable pains to investigate the question under consideration and have been unable to find a single authority in support

> of any other view than that the witnesses attest the signature. Under such circumstances I do not feel authorized to sustain the other view of the construction of the statute, although I quite agree with the eminent authority referred to that the grammatical construction of its language would seem to indicate that the witnesses attest the instrument rather than the signature. . . . I am therefore compelled to sustain the Examiner and deny the petition."

One more reference in connection with this rule. Commissioner Simonds in Ex parte Krause, C. D., 1891, page 164, in reference to the signature to the drawing, said:

> "Section 4889, Revised Statutes, requires the drawings to be signed. Stamped signatures, as used in this case, are not sufficient."

Rule 52 also relates to the drawings and sets forth for the most part details governing the making of Patent Office drawings and in the main concerns the Draftsman's Division only. However, there are two sections thereof which interest us and may be briefly considered; namely, sections 6 and 9.

Section 6 has to do with reference characters on drawings and in connection with this section I wish to call your attention to Ex parte Cook, C. D., 1890, page 81. In this case four different forms of the invention were disclosed on the drawing and each of the forms was designated by the same reference letter. The Examiner objected to the use of the same letter to designate the four forms disclosed on the ground that they were modifications and therefore different structures, and consequently the use of the same letter to indicate the various structures rendered the disclosure confusing. In considering this point, Commissioner Mitchell very clearly and concisely suggested the practice as follows:

> "In the present case four different forms of cleaner are shown, the first form being a bristle-faced brush, as shown in Figs. 1, 2, 3, and 7; the second form being composed of a backing of

wood and a facing of chamois skin, as shown in Fig. 5; the third being composed of a backing of wood faced with India-rubber, as shown in Fig. 6, and the fourth being composed of a stick wrapped with cloth, as shown in Fig. 8. Each of these four different forms of cleaner is designated by the same reference letter F. These parts, though described as equivalent devices, are nevertheless different parts within the meaning of Rule 52, and they clearly come within the prohibition of the rule, which says that the same character must never be used to designate different parts."

"The question immediately under consideration is solved by the language of the present rule. Formerly the rule simply provided that if the same part of the invention appeared in more than one figure it should always be represented by the same letter. As the rule now reads, a prohibitory clause is added, providing that the same character must never be used to designate different parts. The same parts only can be designated by the same character, but *nullum simile est idem*. If alternative constructions or modifications are shown, a permissible method is to employ the same letter with an appended figure or exponent—as A, A^1, A^2, A^3,—thereby at once conforming to the rule and at the same time suggesting the presence of similarity and the absence of sameness."

Section 9 prohibits advertisements of any description on the drawings. It is so clear as to need no comment and I only desire to refer to a letter of the Commissioner to the Chief Draftsman on October 5, 1885, which defines the meaning of the word "advertisement" as used in this section. The letter in substance is as follows:

> The word "advertisement" applies to anything known as such or anything that favors any particular person, place or country. Fictitious names may be used as John Doe and names, etc., that do not favor any particular person, place or country.

Rule 75 relates to affidavits for the purpose of overcoming references. My remarks are confined to the part of the rule concerning domestic patents. In this connection I wish to briefly refer to two decisions to bring out what an affidavit under this rule should set forth.

The first one is Ex parte Saunders, C. D., 1883, page 23. On this point Commissioner Marble said:

> "If the applicant rests his claim of invention upon drawings or devices made by him, he should produce such drawings or machines or furnish copies or representations of the same, in order that the office may judge whether he in fact made the invention claimed in his application."

Commissioner Mitchell in Ex parte Donovan, C. D., 1890, page 109, set forth this point clearly as follows:

> "If the applicant made sketches, he should so state, and produce and describe them; if the sketches were made and lost, and their contents are remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made, the witness should state as nearly as possible the language used in imparting knowledge of the invention to others. By whatever means the applicant claims to have disclosed the invention he must so present those means to the Examiner as to enable him to determine whether or not the invention was present in the disclosure. The mere statement of the applicant that he disclosed the invention is of no avail, either to constitute evidence of disclosure or to impart sufficiency to a statement of facts in themselves inadequate."

The practice was held to be in such cases that where the Examiner believed the affidavit to be insufficient he should reject the claims involved on that ground.

You will note that the rule distinctly provides that an affidavit applies only in the case of a "domestic patent which substantially shows or describes but does not claim the rejected invention." If the rejected invention is claimed in the patent the applicant should make the claim or claims of the patent that clearly read on applicant's construction, so that the question of priority of invention may be determined by an interference proceeding. The practice in this particular was definitely stated in Ex parte Card and Card, C. D., 1904, page 383.

In this decision the Commissioner held that the Examiner was correct in suggesting certain claims of the patent to the applicants for the purpose of interference. Also that the Examiner was right in informing the applicants that unless they made the claims, certain claims in applicants' application which the patentee could make, or which read on the construction disclosed in the patent, would be rejected on the patent. Furthermore, the Examiner rightly fixed a time limit within which the applicants should make the claims suggested.